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|-----------------|-------------|----------------------|---------------------|------------------|
| 10/059,141      | 01/31/2002  | Bernard B. Fresco    | 4029-24 HSF         | 5993             |

1059 7590 02/27/2004

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EXAMINER

SUGARMAN, SCOTT J

ART UNIT PAPER NUMBER

2873

DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/059,141

**Applicant(s)**

FRESCO, BERNARD B.

**Examiner**

Scott J. Sugarman

**Art Unit**

2873

AL

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-16 is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-9 and 17 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 10 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11-24-03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 7-9 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Okano (US 5,305,028). Okano et al in Figure 1 teaches a multifocal ophthalmic lens having a distance optical center (3) having a first portion (1) with first focal properties, the first focal properties being substantially constant throughout the first portion; a second portion (2) having second focal properties extending downwardly from a location adjacent the distance optical center and having a focal length that varies progressively downwardly in the second portion; and two regions (the regions of portion 1 adjacent portion 2) on either side of the second portion, each of the regions having substantially constant focal properties. Since all of portion 1 is distance, the two regions have the same focal properties of the first portion.

Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Ewer et al (US 4,806,010). Ewer et al in Figure 2 teaches a multifocal ophthalmic lens having a distance optical center having a first portion (1) with first focal properties, the first focal properties being substantially constant throughout the first portion; a second portion (3) having second focal properties extending downwardly from a location adjacent the

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distance optical center and having a focal length that varies progressively downwardly in the second portion; and two regions (the regions on either side of dotted lines 9) in the near portion (2), each of the regions having substantially constant focal properties. Since portion 2 is near, at least one of the two regions has different focal properties from the first portion.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okano or Ewer et al. Okano and Ewer et al are cited for reasons set forth above, but do not specifically teach that at least one of the regions has an infinite focal length (essentially no power, or plano). Providing a particular power to any portion or region of the lens is a function of the prescriptive requirements of the wearer. Therefore, it would have been obvious to one of ordinary skill in the art to provide a plano powered region (of infinite focal length) in either the lens of Okano or Ewer et al, since it is merely a function of the prescriptive requirements of the wearer.

***Allowable Subject Matter***

Claims 4, 5, 10 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 12-16 are allowed.

The following is an examiner's statement of reasons for allowance:

The prior art taken either singularly or in combination fails to anticipate or fairly suggest the limitations of independent claim 12, in such a manner that a rejection under 35 U.S.C. 102 or 103 would be proper. The prior art fails to teach a combination of all the claimed features as presented in independent claim 12, which include the joining of a long-distance lens piece with a progressive lens piece in the manner described. In the dependent claims it is the feature of the two regions being different from one another as well as the two regions can be separate lens pieces.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott J. Sugarman whose telephone number is (571)272-2340.

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The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Scott J. Sugarman  
Primary Examiner  
Art Unit 2873

sj  
February 5, 2004